

REMARKS

I. INTRODUCTION

Applicant has amended claims 11, 21, and 27-31. Accordingly, claims 3-6 and 11-33 are presently pending in this application. Applicants respectfully request further examination and reconsideration of the application in view of the foregoing amendments and the following arguments.

II. AMENDMENTS TO THE CLAIMS

Applicants have amended claim 11 to recite limitations previously set forth in the preamble of the claim within the body of the claim. Applicants have amended claims 21 and 27-31 to change the dependency of the claims from cancelled claim 1 to claim 3. Applicants submit that the amendments do not add any new matter.

III. ELECTION OF INVENTION

Applicant hereby elects, with traverse, the invention identified as invention "Group I" (claims 3-6 and 16-32) by the Examiner. Applicant further elects, without traverse, the species identified as "Species I, Figure 1-4" by the Examiner from within Group I. Applicants agree that no claims are generic to all three species identified by the Examiner, but Applicant submits that claims 3-4, 11, 13-15, 27-31 and 33¹ are generic to the species identified as Species I and Species II by the Examiner. Further, Applicants

¹ See Section IV Traversal regarding method claims 11, 13-15 and 33.

submit that each of claims 3-4, 11, 13-15 and 21-33² read onto the elected Species I shown in Figures 1-4.

IV. TRAVERSAL

The requirement for an election of invention for prosecution on the merits is respectfully traversed in part. The Examiner has identified two inventions related as a product and a process of using the product. A product and process of use are distinct if either (1) the process for using as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process. MPEP § 806.05(h). The Examiner argues that the product can be used in a materially different process by asserting that “the jewelry could be used as a decoration on a jacket or other outer wear and not have a therapeutic usefulness.” First, applicants submit that wearing the jewelry on a jacket or other outer wear does not necessarily mean that the object would not also simultaneously perform the claimed method. Second, Applicants submit that the Examiner has improperly relied on a non-utilitarian process (the simple wearing of a piece of jewelry as ornamentation) that essentially eliminates the test laid out in MPEP § 806.05(h). The Examiner’s rationale is akin to taking claims directed to a conveyor and a method of moving articles using the conveyor and then arguing they are distinct because the conveyor can also be used as a bookend. Applicants submit that the term “materially different process” must encompass a utilitarian process within the subject matter generally protectable as a utility patent.

Applicants also submit that the process as claimed—as recited in the amended claims herein—cannot be practiced using a materially different product. In particular,

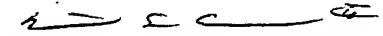
² See Section IV Traversal regarding method claims 11, 13-15 and 33.

method claim 11, as amended, recites the step of providing an item of magnetic jewelry having the same structural attributes as the apparatus recited in claim 3. Accordingly, method claim 11, as amended, cannot be practiced using a materially different product. Because neither of the tests set forth in MPEP § 806.05(h), Applicants respectfully submit that the restriction requirement is improper and/or that the claims, as amended, recite a single patentable invention. Applicants therefore request that the restriction requirement be withdrawn.

V. CONCLUSION

If the Examiner has any questions or concerns, the Examiner is invited to contact the Applicant's undersigned attorney.

Respectfully submitted,


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